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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,212	01/22/2002	Yasuo Nomura	275791US6	4641

22850	7590	09/14/2007
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314		

EXAMINER	
WENDMAGEGN, GIRUMSEW	

ART UNIT	PAPER NUMBER
2621	

NOTIFICATION DATE	DELIVERY MODE
09/14/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

## Office Action Summary

Application No.

10/054,212

Applicant(s)

NOMURA, YASUO

Examiner

Girumsew Wendmagegn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/25/07; 3/15/04; 10/26/06</u>                                | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claim1-6 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim1, 5-6 and 8-10** are rejected under 35 U.S.C. 102(e) as being anticipated by Sasaki et al (Patent No. US 6,226,447).

Regarding claim1, 5-6, and 8-10, Sasaki et al (hereinafter Sasaki) anticipates a recording and playback apparatus for encoding inputted AV signals to produce coded data and recording the coded data into a randomly accessible recording medium and for playing back and decoding the coded data recorded on the recording medium, comprising: production means for encoding the inputted AV signals using a first coding system to produce first coded data (see figure5 element 4); first recording means for recording the first coded data produced by said production means onto the recording medium(see figure5 element 4-7); supervision means for supervising a start of a recording process by said first recording means(see figure5 element 14); readout means for reading out the first coded data recorded on the recording medium by said first recording means from the recording medium(see figure5 element 26); conversion

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means for converting the first coded data read out from the recording medium by said readout means into second coded data corresponding to a second coding system(see figure5 element 27); and second recording means for recording the second coded data converted by said conversion means onto the recording medium(see figure element 19-22); said readout means, conversion means and second recording means being operable to execute the respective processes simultaneously with the recording process by said first recording means, when the start of the recording process by said first recording means is supervised, based on a result of the supervision by said supervision means (see column9 line 57-62).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9/8/07  
Claims 2-4 are  
Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (Patent No. US 6,226,447) as applied to claim 1 and 5 above, and further in view of Seo (Patent No. US 6,798,980).

Regarding claim2, see the teaching of Sasaki above. Sasaki does not teach first coding system is the MPEG2 system and the second coding system is the MPEG1 system. However Seo teaches first coding system, MPEG2 and second coding system MPEG1 (see figure1 element 20 and 50).

One of ordinary skill in the art at the time the invention was made would have been motivated to use MPEG2 and MPEG1 system as in Seo in to Sasaki apparatus because converting MPEG2 to MPEG1 would save storage space.

Regarding claim3, see the teaching of Sasaki above. Sasaki does not teach conversion selects one of a process of converting the first coded data read out from the recording medium by said readout means and another process of outputting the first coded data read out from the recording medium by said readout means as they are without converting the first coded data, and said second recording means records the first or second coded data produced by the process selected by said conversion means onto the recording medium. However Seo teaches recording with or without converting the first coded data (see column2 lines 23-44).

One of ordinary skill in the art at the time the invention was made would have been motivated to record the coded data as in Seo with or without converting it in to another format because it would allow the user to manage the storage space effectively.

Regarding claim4, see the teaching of Sasaki above. Sasaki teaches a recording and playback apparatus according to claim 3, further comprising transfer means for

transferring the first or second coded data produced by said conversion means to another electronic equipment (see figure5 element 13).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

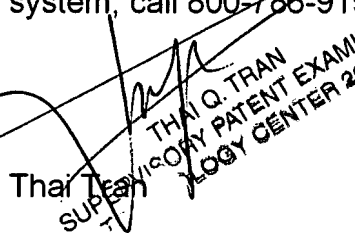
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Girumsew Wendmagegn whose telephone number is 571-270-1118. The examiner can normally be reached on 7:30-5:00, M-F, alr Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
THAI Q. TRAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600  
Thai Tran  
Supervisory Patent Examiner  
Supervisory Patent Examiner

Girumsew Wendmagegn